

**REMARKS**

Claims 1-5, 8-9, and 14-22 are now pending in the above-captioned application.

Claims 6, 10-13, 19, and 23-26 are withdrawn from further consideration in response to the ELECTION OF SPECIES requirement of June 14, 2005. As noted in the previous RESPONSE to the election of SPECIES, the two primary inventions here are the SHINGLESAW™ rotary saw and the AIRKNIFE™ reciprocating saw. Claims 10-13 and 23-26 are directed toward the AIRKNIFE™ reciprocating saw. These claims will be presented in a Divisional Application for further prosecution.

However, claims 6 and 19 are directed toward blade embodiments of the SHINGLESAW™. Upon further reflection, applicant realizes that it makes no sense to examine these claims separately from the elected claims herein. Applicant thus respectfully requests that the ELECTION requirement be modified to include claims 6 and 19 in the claims presently examined.

Since claims 6 and 19 depend from respective generic claims, applicant contends that these claims will have to be considered in any event, upon indication of allowable subject matter in the present application.

**OBJECTION TO THE SPECIFICATION**

The Examiner objected to some minor typographical errors, which have been corrected by the above amendment. Applicant has carefully reviewed the Specification for any additional errors and has taken this opportunity to correct them.

**OBJECTION TO THE ABSTRACT**

The Abstract was objected to due to some minor errors. A substitute ABSTRACT is attached correcting these errors.

**REJECTION UNDER 35 U.S.C. §112, First Paragraph**

Claim 1 was rejected under 35 U.S.C. §112, first paragraph due to some minor informalities which have been corrected by the above amendment.

**REJECTION UNDER 35 U.S.C. §102**

Claim 1 was rejected under 35 U.S.C. §102(b) as being anticipated by Shearon, U.S. Patent No. 4,685,214. Applicant respectfully traverses this rejection.

In order to be complete, an anticipation-type rejection must contain two elements:

1. The reference must qualify as "Prior Art" under one of the sections of 35 U.S.C. §102; and
2. The reference must explicitly teach *ALL* of the features of the claimed invention.

Shearon discloses a cutting tool for metal. See, e.g., Col. 1, lines 14-35. The Shearon Patent is assigned to FMC Corporation, a noted maker of military vehicles. Shearon notes difficulties in cutting metals when working on military vehicles in confined spaces, and proposes a solution, whereby a safety guard can be moved aside in confined spaces without the user having to hold the guard by hand.

Shearon does not teach or suggest an air powered saw for cutting shingles or for other roofing or construction activities (as the term is known in the art).

The elected claims in the present applicant comprise respective APPARATUS and METHOD claims which contain parallel limitations. Applicant notes that the Examiner has not rejected the corresponding method claim 14 under 35 USC 102(b) in view of Shearon – an explicit admission that Shearon does not teach or suggest a “roofer’s saw” (Office Action, Page 6, lines 14-17).

Thus, the rejection hinges on the doctrine of “intended use.” The Federal Circuit has spoken at length on this issue in CATALINA MARKETING INTERNATIONAL, INC. v. COOLSAVINGS.COM, INC. 289 F.3d 801, 62 U.S.P.Q.2d 1781, U.S. Court of Appeals, Federal Circuit, May 08, 2002:

In general, a preamble limits the invention if it recites essential structure or steps, or if it is "necessary to give life, meaning, and vitality" to the claim. *Pitney Bowes*, 182 F.3d at 1305. Conversely, a preamble is not limiting "where a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention." *Rowe v. Dror*, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997).

Applicant has amended claim 1 to include the limitations of dependent claim 7. Claim 7 recites a carbide blade tip with a chipper edged carbide bit, a feature described in Applicant's Figure 9. This feature is neither taught nor suggested by the references cited by the Examiner (and is notably not addressed in the obviousness rejections).

Thus, applicant submits that claim 1, as amended, is now distinguishable over the Prior Art of record.

#### **REJECTION UNDER 35 U.S.C. §103**

Claims 2, 5, 7, and 9 were rejected under 35 U.S.C. §103 as being unpatentable over Shearon in view of Lee and Zimmerman. Applicant respectfully traverses this rejection.

In order to be complete, an obviousness-type rejection must contain two elements:

1. The references, as combined, must show all the features of the claimed invention (all elements rule); and
2. A *proper* motivation to combine the references must be provided.

In this instance, neither element is present.

As noted above, Shearon does not teach or suggest a roofing saw, nor does he teach or suggest a saw having carbide blades with a chipper edge.

Lee and Zimmerman have been combined with Shearon to allegedly show the features of claims 2, 5, 7, and 9. Lee shows only a high speed steel blade with conventional tips. While Lee discloses using the saw in a shingle mill, the term "shingle mill" as known to one of ordinary skill in the art, especially in the context of Lee's 1932 issue date refers to wooden shingles, not asphalt or composite roofing (the latter of which did not exist at the time of the Lee patent).

Zimmerman shows the use of carbide blades in a woodworking machine, but again, is not directed toward on-the-roof applications. Since none of the references teaches or suggests cutting shingles for roofing applications, it is not clear what motivation would be used to combine these three references. Two are directed toward general woodworking, and the third (Shearon) for cutting metal on military vehicles.

The rejection contains no discussion of the limitations of claim 7, or any motivation to make such a limitation obvious. As none of the references disclose applicant's chipper blade tip, the reason for this omission is clear. Applicant has amended claim 1 to include this limitation, and thus all of claims 2-6, and 8-9, which depend from claim 1 are distinguishable over the Prior Art of record.

Claim 3 was rejected under 35 U.S.C. §103 as being unpatentable over Shearon in view of Kelly. Applicant respectfully traverses this rejection. As noted above, claim 1 has been amended to include the limitations of claim 7. Kelly does not teach or suggest the use of a chipper carbide bit.

Claim 4 was rejected under 35 U.S.C. §103 as being unpatentable over Shearon in view of Barrett. Applicant respectfully traverses this rejection. As noted above, claim 1 has been amended to include the limitations of claim 7. Kelly does not teach or suggest the use of a chipper carbide bit.

Claim 8 was rejected under 35 U.S.C. §103 as being unpatentable over Shearon in view of Zimmerman. Applicant respectfully traverses this rejection. As noted above, claim 1 has been amended to include the limitations of claim 7. Zimmerman does not teach or suggest the use of a chipper carbide bit.

**Claim 14 was rejected under 35 U.S.C. §103 as being unpatentable over Shearon in view of Nitz et al.. Applicant respectfully traverses this rejection.**

While the Examiner does not give weight to the limitation of use in a roofing environment for the apparatus claims, in the method claim, the Examiner correctly includes this limitation in the rejection analysis. For this reason, claim 14, a method analog of applicant's apparatus claim1 is rejected under 35 USC 103, and not 35 USC 102.

As noted above, Shearon is directed toward metal working and not roofing. Nitz is combined with Shearon in an attempt to show that using the metalworking saw of Shearon would be obvious in the roofing environment.

Nitz shows an oscillating saw, not a rotary saw. While he may disclose circular blades, it is clear from his description (The Examiner's cited Col. 2, line 4) that the bi-directional blade is designed to oscillate back and forth and not act as a rotary saw. Moreover, Nitz mentions only cutting roofing materials, not trimming roofing materials *in situ* on a roof.

Applicant has discovered a new an improved method of installing roofing materials using the Shinglesaw™ of the present invention. The roofing industry is quite old, and techniques for installing shingles have remained largely unchanged for decades. The Examiner argues that it would be "obvious" to take a rotary air powered saw used by FMC in the manufacture of military vehicles, attach an oscillating blade to it, and use it to trim roofing materials. If such a technique were obvious, however, it begs the question as to why it has not been implemented prior to Applicant's invention thereof. The failure of others to supply an easier and more accurate technique for cutting roofing shingles is one indicia of the non-obviousness of the invention.

Commercial success is another indicia of the success of the invention. Applicant has sold a number of the Shinglesaw™ devices on his website ([www.roofmates.com](http://www.roofmates.com)), through the ABC industrial supply catalog (a "bible" for contractors and construction workers) and also through the CERTAINTED shingle and siding catalog. Certainteed has recognized the Shinglesaw™ as the premier tool for cutting its composite products. In the Spring of 2006, Florida Pneumatic, under license

from Roofmates™ will introduce the Shinglesaw™ into Home Depot and other retail stores across the country.

It is clear that the Shinglesaw™ is an innovation, and moreover is recognized in the roofing industry as an innovation. If the idea were “obvious” certainly some other roofer would have thought of it previously.

Applicant has amended claim 14 to recite that the shingles are cut in situ. Applicant notes that while this claim is directed toward roofing applications, applicant is not limited in presenting claims directed toward other environments in future Patent applications.

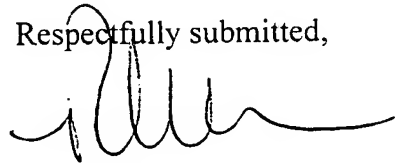
The remainder of the 103 rejection references have already been addressed with regard to the corresponding apparatus limitations above and those comments are incorporated herein.

### **CONCLUSION**

The concept of creating an air-powered saw for use on roofing jobs is neither taught or suggested by the Prior Art of record. Claims 1 and 14 have been amended to more clearly distinguish the present invention over the Prior Art of record. As such, all of claims 1-6, 8-9, and 14-22 are now in condition for allowance.

An early Notice of Allowance is respectfully requested.

Respectfully submitted,



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